

1 REMARKS

2 Status of the Claims

3 Claims 1 – 20, and 36 - 48 remain pending in the application. Applicants have amended  
4 Claims 1, 4, 6, 7, 9, 36, 38 – 43, and 46 to more clearly define the invention, but not to make the  
5 claims patentable over the cited prior art, since the claims as filed already are patentable.  
6 Claims 21 – 35 have been canceled as non-elected in response to a Restriction requirement.

7 Telephone Restriction and Applicants' Election

8 On Nov. 22, 2004, the Examiner called applicants' attorney to issue a Restriction in the  
9 present application. The claims were restricted into Group I that includes Claims 1 – 20 and 36 – 48,  
10 which the Examiner indicated are drawn to a compact scanner and its corresponding method of use,  
11 classified in Class 385, subclass 25; and Group II that includes Claims 21 – 35, identified by the  
12 Examiner as being drawn to a method of manufacturing a fiber optic device, classified in Class 65,  
13 subclass 429. The Examiner noted that the inventions of Group I and II are related as a product and  
14 process of making the product and are distinct because the process can be used to make a materially  
15 different product.

16 In response to the telephone Restriction, applicants' attorney called the Examiner on  
17 November 23, 2004 and elected the claims of Group I, with traverse. Applicants now confirm the  
18 election made during the telephone call with the Examiner, and now choose not to present any  
19 traverse of the restriction. Applicants have therefore canceled the non-elected claims of Group II,  
20 i.e., Claims 21 - 35, subject to applicants' right to file a divisional application that includes these non-  
21 elected claims at anytime during the pendency of the present application. No change in inventorship  
22 is required as a result of canceling the claims from the present application.

23 Claims Rejected under 35 U.S.C. § 102

24 Claims 1 – 4, 6 – 11, 13, 15 – 17, 19 – 20, 36 – 43, 46, and 47 have been rejected as  
25 anticipated by U.S. Patent No. 6,294,775 (Seibel et al., hereinafter referred to as "Seibel"). In  
26 justifying the rejection, the Examiner states that Seibel discloses all of the elements recited by these  
27 claims. Applicants respectfully disagree with the Examiner for the reasons discussed below.

28 In the interest of reducing the complexity of the issues for the Examiner to consider in this  
29 response, the following discussion focuses on amended independent Claims 1, and 36. The  
30 patentability of each remaining dependent claim is not necessarily separately addressed in detail.

1 However, applicants' decision not to discuss the differences between the cited art and each dependent  
2 claim should not be considered as an admission that applicants concur with the Examiner's  
3 conclusion that these dependent claims are not patentable over the disclosure in the cited reference.  
4 Similarly, applicants' decision not to discuss differences between the prior art and every claim  
5 element, or every comment made by the Examiner, should not be considered as an admission that  
6 applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed,  
7 applicants believe that all of the dependent claims patentably distinguish over the references cited.  
8 Moreover, a specific traverse of the rejection of each dependent claim is not required, since  
9 dependent claims are patentable for at least the same reasons as the independent claims from which  
10 the dependent claims ultimately depend.

11 As originally filed, independent Claims 1 and 36 each refer to a waveguide having an  
12 effective light source. The specification defines "effective light source" or ("effective light source  
13 position") as "a position adjacent to the distal end of the waveguide where the waveguide is no longer  
14 internally guiding light." (See page 5, lines 1-3 of applicants' specification). A careful search of the  
15 cited Seibel patent fails to identify any teaching, or suggestion of any feature corresponding to  
16 applicants' effective light source and no teaching or suggestion of a disposition of an effective light  
17 source to the operation of an optical scanning device. Accordingly, even before the amendment made  
18 to the claims as set forth above, the Examiner was not justified in rejecting the claims as anticipated  
19 by or as obvious in view of the disclosure of the Seibel reference.

20 Applicants have amended independent Claims 1 and 36 to indicate how the effective light  
21 source (or effective light source position) is particularly relevant to the invention as defined in the  
22 present application in ways that were not recognized at the time the application that issued as the  
23 Seibel patent was filed. As amended, subparagraph (c) of applicants' Claim 1 reads as follows:

24 (c) an actuator for exciting a portion of the waveguide that is adjacent to  
25 the distal end and is cantilevered from the actuator to vibrate at a desired frequency  
26 and in a desired pattern, excitation of the portion of the waveguide that is cantilevered  
27 from the actuator causing a rotation to occur for scanning a region with light from the  
28 optical component, wherein a characteristic of light emitted from the optical  
component is selectively determined by controlling a spatial relationship between the  
effective light source position and at least one of:

- 29 (i) a back focal point of the optical component; and  
30 (ii) a location of a vibratory node of the portion of the waveguide  
that is cantilevered from the actuator.

1 Subparagraph (b) of Claim 36 has been amended to include a similar recitation of the relationship  
2 between the effective light source and either the back focal plane of the optical component or the  
3 vibratory node of the waveguide. The Examiner must concede that because the cited Seibel reference  
4 does not mention teach or suggest "an effective light source," the cited reference cannot teach or  
5 suggest that a characteristic of light emitted from an optical component in a scanner is selectively  
6 determined by controlling a spatial relationship between an effective light source position and either a  
7 back focal point of the optical component or a location of a vibratory node of the portion of the  
8 waveguide that is cantilevered from an actuator.

9 Since a principal inventor of the cited reference, Eric Seibel, is also a joint inventor of the  
10 present application, it is apparent to applicants that the present invention was neither known at the  
11 time of filing of the Seibel referenced patent, nor was the invention as defined by independent  
12 Claims 1 and 36 in the present application obvious in view of the disclosure in the Seibel patent. The  
13 importance of the effective light source in regard to controlling characteristics of the light emitted by  
14 the waveguide was only determined when the invention recited in the claims of the present  
15 application was conceived. Accordingly, in consideration of the recitation of how the effective light  
16 source (or effective light source position) is spatially related to determining a characteristic of the  
17 light emitted by an optical component in Claims 1 and 36, there is no justification for maintaining the  
18 rejection of the claims in this application over Seibel.

19 Since each dependent claim inherently includes the recitation of the independent claim from  
20 which it ultimately depends, all dependent claims that are rejected as anticipated by the Seibel  
21 reference are also patentable for at least the same reasons as Claims 1 and 36. The Examiner is  
22 therefore requested to withdraw his rejection of these claims.

23 Claims Rejected under 35 U.S.C. § 103(a)

24 The Examiner has also rejected Claims 5, 12, 14, 18, 44, 45, and 48 as unpatentable over  
25 Seibel, in view of U.S. Published Application No. 20020064341 (Fauver et al., hereinafter referred to  
26 as "Fauver"). However, this rejection must be withdrawn, both because, as noted above, each of the  
27 independent claims remaining in the application already distinguishes over Seibel, and because  
28 Fauver is not citable as prior art against the present invention. Specifically, the present invention was  
29 filed after November 29, 1999 (i.e., on January 23, 2004), and applicants' attorney hereby stipulates  
30 that the subject matter of the reference cited, i.e., Fauver, and the present claimed invention were, at

1 the time the invention was made, owned by the University of Washington or subject to an obligation  
2 of assignment to the University of Washington. Applicants wish to thank the Examiner for indicating  
3 that this condition is potentially a basis for avoiding the citation of the Fauver application. In any  
4 case, the rejection of these claims under 35 U.S.C. § 103(a) is not justified and must be withdrawn.

5 In consideration of the remarks set forth above and the amendments to the application, all  
6 claims currently remaining in the case define novel and nonobvious subject matter and are therefore  
7 patentable. Accordingly, the Examiner is requested to pass this case to issue without further delay.  
8 In the event that any further questions remain, the Examiner is invited to telephone applicants'  
9 attorney at the number listed below.

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11 Respectfully submitted,

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14 Ronald M. Anderson  
15 Registration No. 28,829

16 RMA:lrg  
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18 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed  
19 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,  
20 Alexandria, VA 22313-1450, on February 2, 2005.

21 Date: February 2, 2005  
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